UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,117	09/26/2001	Sean R. Parent	07844-471001 / P435	1762

21876	7590	03/15/2005

FISH & RICHARDSON P.C.
3300 DAIN RAUSCHER PLAZA
MINNEAPOLIS, MN 55402

EXAMINER
HOLLAR, ANDREA B

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/965,117	PARENT ET AL.
	Examiner	**Art Unit**	
	Andrea Hollar	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _26 September 2001_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-22_ is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-22_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _07 October 2002_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04) **Office Action Summary** Part of Paper No./Mail Date 20050304

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include

the following reference character(s) not mentioned in the description: 220. Corrected drawing sheets in

compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in

the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should include all of the

figures appearing on the immediate prior version of the sheet, even if only one figure is being amended.

Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as

either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not

accepted by the examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or
in public use or on sale in this country, more than one year prior to the date of application for
patent in the United States.

Claims 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Stent (5,778,359).

With respect to claim 14, Stent discloses a computer program product, tangibly stored on a

machine-readable medium, comprising instructions operable to cause a programmable processor to:

receive a host data file, the host data file having a host data file format that is not understood by

the computer program product (col. 1, line 66 – col. 2, line 1);

scan for a header (col. 2, lines 19-21) that indicates the beginning of an embedded foreign data

block packet that contains a foreign data block (col. 3, lines 50-52), the foreign data block having a format

that is recognizable by the computer program (col. 2, lines 7-9), the header including an identifier

designed to be distinguishable from all other data in the host data file (col. 2, line 9), the header further

describing the characteristics of the foreign data block (col. 3, lines 50-51); and

process the header when the header is located (col. 2, lines 22-23).

With respect to claim 15, Stent discloses instructions to process the foreign data block (col. 2,

lines 26-27).

With respect to claim 16, Stent discloses instructions to stop processing the foreign data block

when a trailer is detected, wherein the trailer indicates the end of the foreign data block (col. 3, lines 53-

54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as
set forth in section 102 of this title, if the differences between the subject matter sought to be
patented and the prior art are such that the subject matter as a whole would have been obvious
at the time the invention was made to a person having ordinary skill in the art to which said
subject matter pertains. Patentability shall not be negatived by the manner in which the invention
was made.

Claims 1-2, 4, 6-8, 10-13, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Stent (5,778,359) in view of Backlund (OOE: A Compound Document Framework).

With respect to claim 1, Stent discloses receiving a foreign data block (col. 3, lines 9-11);

determining characteristics of the foreign data block (col. 2, line 1); and generating packing data that

describes the characteristics of the foreign data block, including data marking the beginning (col. 3, lines

50-52; col. 5, lines 16-18) and end of the foreign data block (col. 3, lines 53-54) and further including an

identifier designed to be distinguishable from all other data in the host data file (col. 2, line 9).

Stent does not expressly disclose receiving a host data file, the host data file having a host data

file format; embedding the packing data and the foreign data block as a foreign data block packet in the

host data file; whereby the foreign data block is identifiable, extractable, and modifiable by computer programs not configured to recognize the host file data format.

Backlund teaches a host data file having a host data file format (p. 2, lines 23-24) into which foreign files can be embedded wherein the foreign data block is identifiable, extractable, and modifiable by application programs that are not configured to recognize the host file data format (p. 2, lines 29-33).

Stent and Backlund are analogous art because they are both from the same field of endeavor of document processing.

At the time of invention it would have been obvious to a person of ordinary skill in the art to use Stent's method of encapsulating data to produce packets that could be embedded into a host file using Backlund's method of creating compound documents. The motivation for doing so would have been to provide Backlund's method with packets that contain a large amount of information about the contained data.

Therefore it would have been obvious to combine Backlund with Stent for the benefit of packets containing a large amount of data to obtain the invention as specified in claim 1.

With respect to claim 2, Stent further discloses that generating packing data includes generating a header for the foreign data block, the header including the identifier and indicating the beginning of the foreign data block packet (col. 3, line 50) and the beginning of the foreign data block (col. 3, lines 50-52; col. 5, lines 16-18).

With respect to claim 4, Stent further discloses that generating packing data includes generating a trailer for the foreign data block, the trailer indicating the end of the foreign data block (col. 3, lines 53-54).

With respect to claim 6, Stent further discloses including padding in the foreign data block packet to allow in-place modifications of the foreign data block that cause the foreign data block to expand (col. 4, line 7).

With respect to claim 7, Stent further discloses that determining characteristics of the foreign data block includes determining a size of the foreign data block (col. 4, lines 3-5); and the amount of padding is a function of the size of the foreign data block (col. 4, lines 5-7).

With respect to claim 8, Backlund further discloses that the foreign data block is a data block not native to the host file format (p. 2, lines 16-18).

With respect to claim 10, Stent further discloses that determining characteristics of the foreign data block includes determining a byte order (col. 4, lines 21-23) and an encoding format of the foreign data block (col. 4, lines 32-33); and generating a header includes generating a header that includes information for specifying the byte order and encoding format of the foreign data block, the encoding format being one of an 8, 16, or 32 bit Unicode format (col. 4, lines 32-33).

With respect to claim 11, Stent further disclose that generating an identifier includes generating a different identifier for each different type of foreign data block when there are multiple types of foreign data blocks in the host data file (col. 2, lines 7-9).

With respect to claim 12, Stent further discloses that the foreign data block includes metadata information that describes the host data file (col. 2, lines 7-9).

With respect to claim 13, Backlund further discloses that receiving a host data file includes receiving a host data file having a non-XML format (p. 2, line 16).

With respect to claim 17, Stent discloses instructions to ensure that the modified foreign data block fits in the foreign data block packet (col. 4, lines 7-9).

Stent does not expressly disclose instructions to modify the foreign data clock as specified by a user; and re-embed the modified foreign data block in place of the original foreign data block.

Backlund discloses the capability to allow user modifications of a foreign data block (p. 2, lines 29-30) and that the modified data block can be re-embedded in place of the original data block (p. 8, lines 3-7).

Stent and Backlund are analogous art because they are both from the same field of endeavor of document processing.

At the time of invention it would have been obvious to a person of ordinary skill in the art to use Stent's method of processing data to produce packets that could be embedded into a host file using Backlund's method of creating and modifying compound documents. The motivation for doing so would

have been to provide Backlund's method with packets that contain a large amount of information about the contained data.

Therefore it would have been obvious to combine Backlund with Stent for the benefit of packets containing a large amount of data to obtain the invention as specified in claim 17.

With respect to claim 18, Stent discloses instructions to ensure that the re-written foreign data block packet is the same size as the original foreign data block packet (col. 4, lines 7-9).

Stent does not expressly disclose instructions to modify the foreign data clock as specified by a user; rewrite the foreign data block packet; and re-embed the modified foreign data block in place of the original foreign data block.

Backlund discloses the capability to allow user modifications of a foreign data block (p. 2, lines 29-30), the capability to rewrite the foreign data block packet (p. 8, line 5), and that the modified data block can be re-embedded in place of the original data block packet (p. 8, lines 3-7).

Stent and Backlund are analogous art because they are both from the same field of endeavor of document processing.

At the time of invention it would have been obvious to a person of ordinary skill in the art to use Stent's method of processing data to produce packets that could be embedded into a host file using Backlund's method of creating and modifying compound documents. The motivation for doing so would have been to provide Backlund's method with packets that contain a large amount of information about the contained data.

Therefore it would have been obvious to combine Backlund with Stent for the benefit of packets containing a large amount of data to obtain the invention as specified in claim 18.

Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Backlund (OOE: A Compound Document Framework) in view of Stent (5,778,359).

With respect to claim 19, Backlund discloses a method for embedding a foreign data block in a host data file, comprising:

receiving a host data file, the host data file having a host data format (p. 2, lines 23-24);

receiving a packet to be embedded into the host data file (p. 2, lines 27-28);

embedding the packet in the host data file (p. 2, lines 29-33);

whereby the foreign data block is identifiable, extractable, and modifiable by computer programs not configure to recognize the host file data format (p. 2, lines 29-30).

Backlund does not expressly disclose that the foreign data block includes a header and a trailer that delimit the foreign data block, the header including an identifier designed to be distinguishable from all other data in the host data file.

Stent discloses a header (col. 3, lines 50-52; col. 5, lines 16-18) and a trailer that delimit the foreign data block (col. 3, lines 53-54) and an identifier designed to be distinguishable from all other data in the host data file (col. 2, line 9).

Stent and Backlund are analogous art because they are both from the same field of endeavor of document processing.

At the time of invention it would have been obvious to a person of ordinary skill in the art to use Stent's method of encapsulating data to produce packets that could be embedded into a host file using Backlund's method of creating compound documents. The motivation for doing so would have been to provide Backlund's method with packets that contain a large amount of information about the contained data.

Therefore it would have been obvious to combine Backlund with Stent for the benefit of packets containing a large amount of data to obtain the invention as specified in claim 19.

With respect to claim 20, Backlund discloses A computer program product, tangibly stored on a machine-readable medium, for embedding a foreign data block in a host data file, comprising instructions operable to cause a programmable processor to:

receive a host data file, the host data file having a host data format that is a native file format for the computer program product (p. 2, lines 23-24);

receive a packet to be embedded into the host data file, the packet including a foreign data block that is not native to the host data file format (p. 2, lines 27-28); and

embed the packet in the host data file (p. 2, lines 29-33);

whereby the foreign data block is identifiable, extractable, and modifiable by computer programs not configured to recognize the host file data format (p. 2, lines 29-30).

Backlund does not expressly disclose a header and a trailer that delimit the foreign data block, the header including an identifier that is designed to be distinguishable from all other data in the host data file.

Stent discloses a header (col. 3, lines 50-52; col. 5, lines 16-18) and a trailer that delimit the foreign data block (col. 3, lines 53-54) and an identifier designed to be distinguishable from all other data in the host data file (col. 2, line 9).

Stent and Backlund are analogous art because they are both from the same field of endeavor of document processing.

At the time of invention it would have been obvious to a person of ordinary skill in the art to use Stent's method of encapsulating data to produce packets that could be embedded into a host file using Backlund's method of creating compound documents. The motivation for doing so would have been to provide Backlund's method with packets that contain a large amount of information about the contained data.

Therefore it would have been obvious to combine Backlund with Stent for the benefit of packets containing a large amount of data to obtain the invention as specified in claim 20.

With respect to claim 21, Backlund discloses a computer program product, tangibly stored on a machine-readable medium, for embedding a foreign data block in a host data file, comprising instructions operable to cause a programmable processor to:

receive a host data file, the host data file having a host data file format that is a native file format for a host application (p. 2, lines 23-24);

receive a foreign data block, the foreign data block being a data block that is not native to the host data file format (p. 2, lines 27-28); and

embed the information and the foreign data block as a foreign data block packet in the host data file (p. 2, lines 29-33);

whereby the foreign data block is identifiable, extractable, and modifiable by computer programs

not configured to recognize the host file data format (p. 2, lines 29-30).

Backlund does not disclose instructions to generate information that describes the characteristics

of the foreign data block, including information marking the beginning and end of the foreign data block

and further including an identifier designed to be distinguishable from all other data in the host data file.

Stent discloses instructions for determining characteristics of the foreign data block (col. 2, line 1)

and information marking the beginning and end of the foreign data block (col. 3, lines 50-52; col. 5, lines

16-18; col. 3, lines 53-54) and an identifier designed to be distinguishable from all other data in the host

data file (col. 2, line 9).

Stent and Backlund are analogous art because they are both from the same field of endeavor of

document processing.

At the time of invention it would have been obvious to a person of ordinary skill in the art to use

Stent's instructions for encapsulating data to produce packets that could be embedded into a host file

using Backlund's program for creating compound documents. The motivation for doing so would have

been to provide Backlund's method with packets that contain a large amount of information about the

contained data.

Therefore it would have been obvious to combine Backlund with Stent for the benefit of packets

containing a large amount of data to obtain the invention as specified in claim 21.

With respect to claim 22, Backlund discloses a computer program product, tangibly stored on a

machine-readable medium, for embedding metadata in a host data file having a non-XML format,

comprising instructions operable to cause a programmable processor to:

receive a host data file having a format that is not XML and that is a native file format for a host

application (p. 2, lines 23-24, 16);

receive metadata having a format that is not native to the host data file format (p. 2, lines 27-28);

and

embed the information and the metadata as a packet in the host data file (p. 2, lines 29-33);

whereby the metadata is identifiable, extractable, and modifiable by computer programs not

configured to recognize the host file data format (p. 2, lines 29-30).

Backlund does not expressly disclose instructions to determine characteristics of the metadata

and generate information that describes the characteristics of the metadata, including information marking

the beginning and end of the metadata and further including an identifier designed to be distinguishable

from all other data in the host data file.

Stent discloses instructions to determine characteristics of the metadata (col. 2, line 1) and

information marking the beginning and end of the metadata (col. 3, lines 50-52; col. 5, lines 16-18; col. 3,

lines 53-54) and an identifier designed to be distinguishable from all other data in the host data file (col. 2,

line 9).

Stent and Backlund are analogous art because they are both from the same field of endeavor of

document processing.

At the time of invention it would have been obvious to a person of ordinary skill in the art to use

Stent's instructions for encapsulating data to produce packets that could be embedded into a host file

using Backlund's program for creating compound documents. The motivation for doing so would have

been to provide Backlund's method with packets that contain a large amount of information about the

contained data.

Therefore it would have been obvious to combine Backlund with Stent for the benefit of packets

containing a large amount of data to obtain the invention as specified in claim 22.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stent in view of Backlund

as applied to claims 1 and 2 above, and further in view of Erickson (2004/0210535) and Parks

(6,850,228).

Stent and Backlund do not expressly disclose a header that indicates the end of the foreign data

block packet.

Erickson indicates that the data block can be at the end of an encapsulated document (par. 93).

Parks shows that a header can indicate the length (and therefore the end) of a data block (col. 2, line 16).

If the data block is at the end of the document, as taught by Erickson, the Parks' length would indicate the end of the document. Therefore, Erickson and Parks show that a header can indicate the end of a foreign data block packet.

Stent, Backlund, Erickson, and Parks are all analogous art because they are all from the same field of endeavor of document processing.

At the time of invention it would have been obvious to a person of ordinary skill in the art to allow Stent's method to include a header that indicates the end of the foreign data block packet. The motivation for doing so would have been to indicate to Backlund's method the end of the packet to be embedded.

Therefore it would have been obvious to combine Erickson and Parks with Stent and Backlund for the benefit of additional information about the packet to be embedded to obtain the invention as specified in claim 3.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stent in View of Backlund as applied to claims 1 and 2 above, and further in view of Parks (6,850,228).

Stent and Backlund do not expressly disclose a header that indicates the end of the foreign data block.

Parks teaches that headers can indicate the length, and therefore the end, of a data block (col. 2, line 16).

Stent, Backlund, and Parks are all analogous art because they are all from the same field of endeavor of document processing.

At the time of invention it would have been obvious to a person of ordinary skill in the art to allow Stent's method to include a header that indicates the end of the foreign data block. The motivation for doing so would have been to indicate to Backlund's method the end of the block to be embedded.

Therefore it would have been obvious to combine Parks with Stent and Backlund for the benefit of additional information about the block to be embedded to obtain the invention as specified in claim 5.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stent in view of Backlund as applied to claim 1 above, and further in view of Walsh (6,810,429).

Backlund discloses that the host file is in a non-XML format (p. 2, line 16).

Stent and Backlund do not expressly disclose that the foreign data block is an XML document.

Walsh discloses that XML documents can be embedded into documents of a different type (col. 13, lines 18-20).

Stent, Backlund, and Walsh are all analogous art because they are all from the same field of endeavor of document processing.

At the time of invention it would have been obvious to allow Backlund's method to accept an XML document as a document to be embedded into a non-XML file. The motivation for doing so would have been to broaden the types of files that Backlund's method can accept as embedded data.

Therefore it would have been obvious to combine Walsh with Stent and Backlund for the benefit of broadening the types of files that Backlund's method can accept to obtain the invention as specified in claim 9.
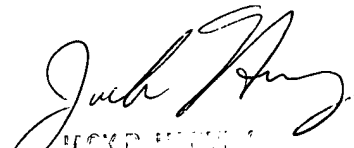
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea Hollar whose telephone number is 571-272-5862. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 571-272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ABH